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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79153067
Applicant	Universal Entertainment Corporation
Applied for Mark	ULTRA STACK POSEIDON
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application No.: **79/153,067** : Law Office: **104**

Filed: **July 17, 2014** : Examining Attorney:

Applicant and Appellant: : **Christine Martin**

Universal Entertainment Corporation :

Mark: **ULTRA STACK POSEIDON** :

APPEAL BRIEF

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A. INTRODUCTION

Universal Entertainment Corporation (hereinafter “Applicant”) appeals the Examining Attorney’s final refusal to register the Applicant’s mark ULTRA STACK POSEIDON, U.S. Serial No. 79/153,067, for use with the following goods in International Class 028:

Gaming machines; gaming machines with multi-terminals; home video game machines; magnetic card operated arcade video game machines; arcade video game machines with multi-terminals; arcade video game machines; slot machines; coin-operated arcade video game machines; hand-held games with liquid crystal displays

The Examining Attorney refused to register Applicant’s mark under section 2(d), because of an alleged likelihood of confusion with the mark POSEIDON in U.S. Registration No. 3,823,156 for “gaming machines, namely, devices which accept a wager” in International Class 009.

For the reasons stated below, Applicant respectfully requests the Trademark Trial and Appeal Board reverse the Examining Attorney’s refusal.

B. THE RECORD

The record for this appeal consists of the prosecution history of U.S. Application Serial No. 79/153,067, which includes the following documents and exhibits:

An application for extension of protection from International Application No. 1218562 dated October 9, 2014;

An Office Action dated October 31, 2014 with attachments;

A response to the Office Action dated February 4, 2015, with Exhibit A (a printout listing 22 records, showing that the applicant has twelve (12) trademark registrations and another ten (10) pending applications which include the ULTRA STACK prefix), Exhibit B (a press release dated September 17, 2013), Exhibit C (article entitled “Aruze goes the extra mile with Ultra Stack,” dated

January 21, 2014), Exhibit D (advertisement for an extension of Applicant's ULTRA STACK series), and Exhibit E (an article from the Casino Journal);

A Final Office Action dated February 19, 2014, with attachments 1-46;

A Request for Reconsideration dated August 5, 2015, with Exhibit A (listing of Applicant's global applications/registrations for marks containing ULTRA STACK);

A Notice of Appeal, filed August 5, 2015; and,

A denial of the Request for Reconsideration dated August 27, 2015, with attachments 1-49.

C. ISSUE PRESENTED

Whether Applicant's mark ULTRA STACK POSEIDON is confusingly similar to the registered mark POSEIDON.

D. ARGUMENT

1. BACKGROUND

Likelihood of confusion under the Lanham Act, 15 U.S.C. §1052(d) is a legal determination based upon factual underpinnings. *On-Line Careline, Inc. v. Am. Online, Inc.*, 56 USPQ2d 1471 (Fed. Cir. 2000). The determination is made by reference to the thirteen factors set forth in *In re E.I. Du Pont de Nemours & Co.*, 176 USPQ 1736 (CCPA 1973).

The Examining Attorney refused registration of the Applicant's mark on the grounds that the applied-for-mark ULTRA STACK POSEIDON is so similar to the Registered mark POSEIDON as to cause a likelihood of confusion. However, fair consideration of the relevant

factors set out in *In re E.I. du Pont de Nemours & Co.*, supra, establishes that there is no such likelihood of confusion.

2. THE MARKS DIFFER IN APPEARANCE

The first DuPont factor is of particular importance, and is directed to “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005).

In comparing the marks, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether they are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *Midwestern Pet Foods Inc., v. Societe des Produits Nestle S.A.*, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012).

Similarity or dissimilarity is determined based on the marks in their entireties. It is improper to dissect the marks into their various components, as the analysis must be based on the entire marks, not just the parts thereof. *In re Nat’l Data Corp.*, 224 USPQ 749, 751 (Fed. Cir. 1985); see also *Franklin Mint Corp. v. Master Mfg. Co.*, 212 USPQ 233, 234 (CCPA 1981) (a mark should not be dissected and considered piecemeal; rather, the mark must be considered as a whole in determining likelihood of confusion).

As to appearance, when considered in their entirety, the marks differ significantly. The inclusion of the phrase ULTRA STACK before POSEIDON in the applied-for-mark creates a very distinct appearance when compared to POSEIDON of the Registered mark alone. The Examining Attorney asserts in the Office Action that the marks are similar, because both the applied-for-mark

and the Registered mark include the formative POSEIDON. However, the Examining Attorney has placed too great of weight on the similarities between the marks, and disregarded the other formatives of “ULTRA” and “STACK” in the applied-for-mark.

The fact that Applicant’s multi-word mark encompasses the whole of Registrant’s one-word mark does not automatically result in likelihood of confusion, to the contrary, the opposite result has been found where differences in sound, appearance and/or impression are involved. *See Electronic Realty Assocs., Inc. v. Kayser-Roth Corp.*, 216 USPQ 61, 64 (TTAB 1982) (citing *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 167 USPQ 529 (CCPA 1970) (PEAK and PEAK PERIOD), *Kayser-Roth Corp. v. Morris, Co., Inc.*, 164 USPQ 153 (TTAB 1969) (PAUL JONES ESQUIRE and ESQUIRE) and *In re The Pelvic Anchor Corp.*, 166 USPQ 217 (TTAB 1970) (PELVIC ANCHOR and ANCHOR)).

The Examining Attorney has provided no reasons why POSEIDON in the applied-for-mark should be given more weight in comparing the applied-for-mark to the Registered mark. Instead, there are several reasons why ULTRA STACK in the applied-for-mark should be given greater weight in the comparison of the marks. *See In re Cynosure Inc.*, 90 USPQ2d 1644, 1646 (TTAB 2009) (in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of the mark, provided the ultimate conclusion rests on consideration of the marks in their entirety); *see also In re Viterra Inc.*, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (although marks are compared in their entirety, one feature of a mark may be more significant or dominant in creating a commercial impression).

The applied-for-mark begins with the formatives “ULTRA” and “STACK,” and consumers are generally more inclined to focus on the first part of any trademark. *See Palm Bay*

Imps., Inc., 73 USPQ2d at 1692; *see also Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered when making purchasing decisions). Therefore, the formatives “ULTRA” and “STACK” will make the first impression on consumers, and serve as a basis for providing a distinction between the applied-for-mark and the Registered mark.

In addition, the inclusion of the formatives “ULTRA” and “STACK” in the applied-for-mark creates a distinctly different mark in terms of appearance and sound from the Registered mark of POSEIDON alone. *Plus Prods. v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983) (the addition of “MEAT” to “PLUS” is sufficient to distinguish applicant’s mark as a whole from that of “PLUS” per se, notwithstanding the fact that “MEAT” has been disclaimed); *see also Electronic Reality Assocs., Inc.*, 216 USPQ at 63 (GOLDEN ERA and ERA exhibit clear dissimilarities in appearance and sound). The presence of the two additional formatives “ULTRA” and “STACK” in the applied-for-mark visually distinguishes the applied-for-mark from the single word Registered mark.

3. THE MARKS DIFFER IN SOUND

The applied-for-mark and the Registered do not convey the same sound as a result of the additional formatives “ULTRA” and “STACK” in the applied-for-mark. When considered in their entireties, ULTRA STACK POSEIDON and POSEIDON have only a partial overlap in sound or pronunciation, with the formatives “ULTRA” and “STACK” creating additional distinct sounds in the pronunciation of the applied-for-mark compared to the Registered mark. Even though there may be some overlap, “[t]he fact that one mark may bring another mark to

mind does not in itself establish likelihood of confusion as to the source.” *In re P. Ferrero & C. S.p.A.*, 178 USPQ 167, 168 (CCPA 1973); *see also Eli Lilly & Co. v. Natural Answers Inc.*, 56 USPQ2d 1942, 1946 (7th Cir. 2000). The additional formatives of “ULTRA” and “STACK” create three additional emphatic syllables in the applied-for-mark that cause the applied-for-mark to convey a distinct sound when compared with the Registered mark.

4. THE MARKS DIFFER IN CONNOTATION

Even though the applied-for-mark and Registered mark, as discussed above, have differences in appearance and sound, it has been found that even where marks are identical, there is no likelihood of confusion where the marks convey different meanings. *See e.g. In re British Bulldog, Ltd.*, 224 USPQ 854, 856 (TTAB 1984) (no likelihood of confusion between PLAYERS for men’s underwear and PLAYERS for shoes); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629, 630 (TTAB 1977) (no likelihood of confusion between BOTTOMS UP for ladies’ and children’s underwear and BOTTOMS UP for men’s suits, coats and trousers).

5. THE PURCHASERS ARE SOPHISTICATED

Another relevant factor in analyzing whether there is a likelihood of confusion between respective marks involves “the conditions under which and buyers to whom sales are made, i.e. ‘impulse’ v. careful, sophisticated purchasing.” *In re E.I. Du Pont de Nemours & Co.*, 177 USPQ at 567. The Registrant’s goods and Applicant’s goods include gaming machines sold into the highly regulated gaming industry. The goods themselves and procedures for their marketing, sale, operation and maintenance, are highly regulated. Furthermore, gaming is part of the entertainment industry in general, where there is a heightened awareness of trademarks and buyers would likely have sufficient knowledge in the field of trademarks so as to make source

confusion unlikely. In addition, the goods are also very expensive. *See In re Thor Tech Inc.*, 113 USPQ2d 1546, 1551 (Fed. Cir. 2015) (in making purchasing decisions regarding expensive products the reasonably prudent person standard is elevated to the standard of the discriminating purchaser).

Only properly licensed buyers may purchase the gaming machines of the Applicant and the Registrant, because the gaming industry is highly regulated. The purchasing decision thus has to be made with due care and deliberation, and the buyers of gaming machines, such as those sold by the Applicant and the Registrant, are sophisticated purchasers. When the purchasers of a product are highly trained professionals, they know the market and are less likely than untrained consumers to be misled or confused by any perceived similarities of different marks. *See Virgin Enters. Ltd. v. Nawab*, 67 USPQ2d 1420, 1428 (2d Cir. 2003) (professional buyers are expected to have greater powers of discrimination). Even where the consumers may be the same, their sophistication is important and often dispositive because sophisticated consumers are expected to exercise greater care. *Elec. Design & Sales Inc. v. Elec. Data Sys. Corp.*, 21 USPQ2d 1388, 1292 (Fed. Cir. 1992).

Buyers of gaming machines are generally familiar and conscious of trademarks and other identification displayed, for example on slot machines. Given the large numbers of such machines generally present on a gaming floor, a buyer of such machines would consider the attractiveness of a name or mark associated with a machine in making a purchasing decision, along with other technical features, and these purchasers would certainly be able to distinguish POSEIDON from ULTRA STACK POSEIDON and understand that these need not come from a common source simply because they both include the word POSEIDON. *In re N.A.D. Inc.*, 224 USPQ 969, 971 (Fed. Cir. 1985) (sophisticated purchasers who would buy with great care and

unquestionably know the source of the goods could readily distinguish NARKOMED from NARCO); *see also Hewlett-Packard Co. v. Human Performance Measurement Inc.*, 23 USPQ2d 1390, 1396 (TTAB 1992) (highly educated, sophisticated purchasers who know their equipment needs are expected to exercise a great deal of care in equipment selection).

While the gaming machines of Applicant and the Registrant may be made available to the general adult public, only properly licensed buyers may purchase gaming machines. Therefore, it is irrelevant that the general consuming public may ultimately use the gaming machines, because Applicant is not attempting to register its mark ULTRA STACK POSEIDON for gaming related services, and the general consuming adult public is not the purchaser or potential purchaser of Applicant's gaming machines. In determining whether there exists a likelihood of confusion, the proper inquiry centers on the confusion of the consumers in the market for the particular product at issue. *Cont'l Plastic Containers Inc. v. Owens-Brockway Plastic Prods. Inc.*, 46 USPQ2d 1277, 1282 (Fed. Cir. 1998).

In *Cont'l Plastic Containers*, the Court of Appeals for the Federal Circuit found the trade dress of plastic juice bottles to not be confusingly similar, because wholesale purchasers were found to be sophisticated buyers unlikely to be confused over the source of the bottles. *Id.* The Court of Appeals for the Federal Circuit stated that consumers of the juice contained within the bottles were not the relevant consumers for purposes of likelihood of confusion of the trade dress of the bottles, because the juice consumers were buying juice and not purchasing the plastic bottles. *Id.* Likewise, the general consuming adult public is not the purchasers of the gaming machines themselves, and therefore the level of care is that of a properly licensed professional buyer of gaming machines for the gaming industry.

Both the applicant and the registrant use their marks on expensive goods sold in the highly regulated gaming industry to sophisticated purchasers who are more discriminating and not likely to be confused as to the source or origin of the respective goods sold under their respective trademarks. *Elec. Design & Sales Inc.*, 21 USPQ2d at 1392 (there is always less likelihood of confusion where goods are expensive and purchased after careful consideration)

6. CONCLUSION

Given the knowledge, care and deliberation required of buyers within the gaming industry in making the purchasing decisions with respect to Applicant's and the Registrant's goods, the noticeably distinguishable differences in appearance, sound and meaning in the applied-for-mark ULTRA STACK POSEIDON and the Registered mark POSEIDON creating completely distinct commercial impressions, it is clear that confusion between the respective marks is unlikely.

Consequently, Applicant respectfully requests that the refusal to register the mark ULTRA STACK POSEIDON be reversed.

Respectfully submitted,

Dated: November 6, 2015

/Keith R. Obert/
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